

### REMARKS

This paper is filed in response to the Office Action mailed on February 26, 2004. Presently, Claims 1-61 are pending. Of these, Claims 33-61 are withdrawn from consideration. Claims 33-61 are being canceled without prejudice to the filing of continuing applications drawn to the subject matter of the canceled claims. Claims 1-32 have been examined and stand rejected. Claims 62-95 are new. Consideration of Claims 1-32 and 62-95 is respectfully requested.

#### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

1. Claims 1-32, drawn to a method of depositing a release agent,
2. Claim 33, drawn to a mold made by a method of depositing a release agent,
3. Claims 34-58, drawn to a method for making a thermoset-molded body,
4. Claim 59, drawn to a mold made by the method of making a thermoset molded body, and
5. Claims 60-61, drawn to a system for making a molded body.

Applicants affirm the election of Claims 1-32, without traverse, for initial prosecution. Accordingly, Claims 33-61 are canceled without prejudice. New Claims 62-95 are drawn to a method of depositing a release agent, therefore Claims 62-95 belong to Invention 1.

#### The Rejection of Claims 1-32 Under 35 U.S.C. § 112, Second Paragraph

Claims 1-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully disagree. Claim 1 is definite to the degree required by § 112, second paragraph since the scope of the claim is reasonably ascertainable by those skilled

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in the art. *Ex parte Porter*, 26 U.S.P.Q.2d 1144, 1145 (Bd. Pat. App. & Int. 1992); M.P.E.P. § 2173.05(e), p. 2100-200.

Nevertheless, to expedite a Notice of Allowance, the term "mold" has been deleted from Claim 1. Therefore, withdrawal of the rejection of Claims 1-32 is respectfully requested.

The Rejection of Claims 1 and 28-29 Under 35 U.S.C. § 102(e)

Claims 1 and 28-29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kawamoto et al. (U.S. Patent No. 6,347,584).

Claim 1 recites "providing a solution comprising the release agent and water."

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because the Kawamoto et al. reference does not describe a solution comprising water, the reference is not anticipatory.

Furthermore, the Kawamoto et al. reference does not remotely suggest a solution comprising water. In fact, on Col. 3, lines 19-23, the Kawamoto et al. reference describes the opposite of aqueous solutions, "[n]ext, intaglio 1 is dipped into a non-aqueous organic solvent containing first releasing agent 2a dissolved therein. An example of a first releasing agent is perfluoro alkyl group containing silane compound. Non-aqueous organic solvents such as cyclohexane can be used as the solvent." (Emphasis added.)

The Kawamoto reference specifically describes the solution of the second releasing agent as being non-aqueous also, "[n]ext, in order to form second releasing layer 3, intaglio coated with first releasing layer 2 on its surface is dipped into a non-aqueous organic solvent containing stable second releasing agent 3a, such as fluoro-silicone compounds, dissolved therein." (Emphasis added.) See Col. 3, lines 56-60.

Therefore, Claim 1 and Claims 28 and 29 that are directly dependent from Claim 1 are neither anticipated nor obvious in view of the Kawamoto et al. reference.

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Accordingly, the withdrawal of the rejection of Claims 1, 28 and 29 is respectfully requested.

The Rejection of Claims 2-10, 17 and 19 Under 35 U.S.C. § 103(a)

Claims 2-10, 17 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawamoto et al. as applied to Claim 1 above, and further in view of Kinoshita (U.S. Patent No. 6,225,205) and Konuma et al. (U.S. Patent No. 5,856,853).

Claims 2-10, 17 and 19 are ultimately dependent from Claim 1. Neither the Kinoshita nor the Konuma reference describes or remotely suggest the elements that are lacking in the Kawamoto reference.

Accordingly, Claims 2-10, 17 and 19 are allowable over the references of record.

The Rejection of Claims 11-16 and 18 Under 35 U.S.C. § 103(a)

Claims 11-16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawamoto et al., Kinoshita, and Konuma et al., as applied to Claim 10 above, and further, in view of Jacobson (U.S. Patent No. 5,071,676).

Claims 11-16 and 18 are ultimately dependent from Claim 1. Jacobson does not describe or remotely suggest the elements that are lacking in the Kawamoto reference. Accordingly, Claims 11-16 and 18 are allowable over the references of record.

The Rejection of Claims 20-23 and 30 under 35 U.S.C. § 103(a)

Claims 20-22 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kawamoto et al. reference as applied to Claim 1 above.

The Examiner states, "It would have been obvious to employ aqueous or non-aqueous solution depending on polarity and exact nature of release agent."

This statement incorrectly presumes that release agents are interchangeable in the Kawamoto process. The Kawamoto reference is not silent on the issue. The Kawamoto

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reference explicitly states that the solutions of release agent are non-aqueous. This is for a reason. The Kawamoto reference describes the application of two release layers, one is bound by chemical absorption and the second by physical absorption. The Kawamoto reference requires a release agent that has hydrolyzable functional groups in order to be chemically absorbed to the substrate. Such release agents cannot be in a water solution because the functional groups would be hydrolyzed prematurely and would therefore be incapable of chemical absorption. Applicants submit the proposed modification of adding water in the release agent solution described in the Kawamoto reference would render the prior art invention being modified unsatisfactory for its intended purpose, therefore there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); M.P.E.P. § 2143.01, pages 2100-2124.

The Examiner states that it would have been obvious to employ agents that are compatible with water. Applicants submit such proposed modification of the prior art would change the principle of operation of the prior art invention being modified, therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). As discussed immediately above, the addition of water as a solvent is not described or suggested in the Kawamoto reference for a reason. The Kawamoto reference requires the use of release agents having hydrolyzable functional groups. If the release agents are interchanged with release agents that are compatible with water, i.e., with agents that don't have hydrolyzable groups, chemical absorption of the release agent would not be achieved. Therefore, such modification is directly in contradiction with the goal of the Kawamoto reference which is to chemically absorb a release agent on the surface of the intaglio.

Accordingly, for the reasons discussed above, Claim 1 is not obvious in view of the Kawamoto reference. Since Claims 20-23 and 30 are ultimately dependent on Claim 1, these claims are allowable.

The Rejection of Claim 27 Under 35 U.S.C. § 103(a)

Claim 27 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawamoto et al. as applied to Claim 1 above, and further, in view of Metzger (U.S. Patent No. 5,925,231).

Claim 27 is ultimately dependent on Claim 1. The Metzger reference does not describe or remotely suggest the elements that are lacking in the Kawamoto reference. Accordingly, Claim 27 is allowable.

Allowable Subject Matter

Applicants note with appreciation the indication of allowance of Claims 24-26 and 31-32.

New Claims 62-95

Claim 62 recites "applying ultrasonic energy to generate bubbles in the solution to transport the release agent to the surface of the workpiece to coat the release agent to the workpiece surface." Claims 63-93 are ultimately dependent on Claim 62. In direct contrast to Claim 62, the Kawamoto reference describes, "[t]he presence of bubbles may inhibit the reaction between the intaglio surface and respective release agents 2a, 3a, thus making it difficult to form the first and second releasing layers 2, 3, on the surface of the intaglio." (Col. 4, lines 6-11.) The Kawamoto reference also describes, "[t]he ultrasonic vibration can remove the bubbles entrapped in the grooves of the intaglio, thus ensuring the reaction of the releasing agent with the intaglio and formation of the uniform releasing layers on the surface of the intaglio." (Col. 5, lines 46-50.) The Kawamoto reference does not appreciate nor recognize the advantages of generating bubbles by ultrasonic means to transport the release agent to workpiece surfaces where it can bind to the surface. In direct contrast, the Kawamoto reference describes the

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intentional removal of unwanted bubbles from the surface. If a reference teaches against the claimed invention there is no *prima facie* case of obviousness.

Accordingly, the Kawamoto reference does not describe or remotely suggest the invention that is defined by Claims 62-93.

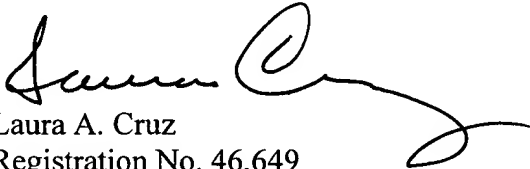
Claim 94 recites providing a workpiece having a feature desired to be coated with a release agent; providing a solution comprising the release agent and water, wherein the workpiece is placed within said solution; and providing cavitation energy to the solution, said workpiece being exposed to said energy to coat the feature with a film containing the release agent. For the reasons discussed above in association with the rejection of Claim 1 in view of the Kawamoto reference, Claims 94 and 95 are allowable.

CONCLUSION

In view of the foregoing remarks and amendments, applicants respectfully submit that Claims 1-32 and 62-95 are in condition for allowance. If the Examiner has any further questions that can expedite a Notice of Allowance, the Examiner is invited to contact the applicants' attorney at the number provided below.


Respectfully submitted,

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